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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LALITHA VAIDYANATHAN,
JOHN QUINN, AHMED KHAISHGI, and
CARA CHERRY

Appeal 2008-2537
Application 09/504,159
Technology Center 3600

Decided:¹ March 31, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
DAVID B. WALKER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Lalitha Vaidyanathan, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the non-final rejection of claims 1-17, 20-22, 25-31, 64-73, 93-100, and 108-117. Claims 18, 19, 23, 24, 32-63, and 74 have been cancelled and claims 75-92 and 101-107 have been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

The claimed invention relates to an electronic dispute resolution system.

Claims 1 and 112, reproduced below, are the independent claims and are illustrative of the subject matter on appeal.

1. A method for resolving an electronic commerce dispute involving one or more parties, comprising:
 - electronically providing access to an online dispute resolution system to allow at least one of the parties to initiate a filing of the dispute from an online marketplace;
 - electronically receiving with the online dispute resolution system transaction data from the marketplace, wherein the transaction data describes transactions within the marketplace;
 - receiving from at least one of the parties

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Aug. 6, 2007) and Reply Brief ("Reply Br.," filed Feb. 5, 2007), and the Examiner's Answer ("Answer," mailed Oct. 2, 2007).

information related to the dispute; and
executing software with the online dispute
resolution system to apply an online dispute
resolution process that utilizes at least a portion of
the transaction data from the market place and
the information to assist the parties in resolving the
dispute.

112. A system comprising:

an online dispute resolution system that
electronically receives transaction data from a
marketplace that provides a web-based community
having buyers and sellers of goods and services,
the transaction data describing transactions within
the electronic marketplace,

wherein the dispute resolution system
executes software that utilizes the transaction data
and applies a dispute resolution process to assist
the buyers or sellers in resolving disputes relating
to the transactions, and

wherein the online dispute resolution system
electronically provides status data to the
marketplace based on participation of the buyers or
sellers within the online dispute resolution
process.

THE REJECTIONS

The Examiner relies upon the following as evidence of
unpatentability:

| | | |
|---------|--------------------|---------------|
| Sloo | US 5,895,450 | Apr. 20, 1999 |
| Collins | US 2002/0007362 A1 | Jan. 17, 2002 |
| Slaikou | US 2001/0007106 A1 | Jul. 5, 2001 |

The Examiner also relies on copies of webpages attributed to the
website www.truste.com and retrieved via a search for that site on the

Internet archive site “Wayback Machine” for the period 1996 through 2003. Answer 28-30. Hereinafter referred to as “TRUSTe.”

The following rejections are before us for review:

1. Claims 111 and 115 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 1-17, 20-22, 25-27, 64-73, 93-100, 109-113, and 115 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloo and Collins.
3. Claim 108 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloo and Slaikeu.
4. Claims 28-31, 114, 116, and 117 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloo, Collins, and TRUSTe.

ISSUES OF LAW

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 111 and 115 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-17, 20-22, 25-27, 64-73, 93-100, 109-113, and 115 under 35 U.S.C. § 103(a) as being unpatentable over Sloo and Collins.

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claim 108 under 35 U.S.C. § 103(a) as being unpatentable over Sloo and Slaikeu.

The fourth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 28-31, 114, 116, and 117 under 35 U.S.C. § 103(a) as being unpatentable over Sloo, Collins, and TRUSTe.

PRINCIPLES OF LAW

Written Description

“What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002). All that is necessary to satisfy the description requirement is to show that one is “in possession” of the invention. The decision in *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997) accurately states the test.

One shows that one is “in possession” of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. *Id.* (“[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.”) (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used in *haec verba*, see *Eiselstein v. Frank*, 52 F.3d 1035, 1038 . . . (Fed. Cir. 1995) (“[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims . . .”), the specification must contain an equivalent description of the claimed subject matter.

Lockwood v. Am. Airlines, Inc., 107 F.3d at 1572. Compliance with the written description requirement is a question of fact. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 111 and 115 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claim 111 depends on method claim 1 and further limits that method by requiring (a) the online dispute resolution and the marketplace to have separate databases and (b) including a step of “automatically electronically

communicating the transaction data between the database of the online dispute resolution system and the database of the electronic marketplace.” Similarly, claim 115 depends on system claim 112 and further limits that system by requiring (a) the online dispute resolution and the marketplace to have separate databases and (b) limiting the online dispute resolution system such that it “comprises a data manager software application to automatically communicate data between the database of the online dispute resolution system and the database of the electronic marketplace.”

The Examiner took the position that the two requirements in each of claims 111 and 115 listed above have no support in the Specification. According to the Examiner, “[t]he claim(s) contain[] subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Answer 4.

“the online dispute resolution system and the marketplace have separate databases”

In their Appeal Brief, the Appellants argued that the Examiner’s position was contradicted by the disclosure on the Specification. “As a starting point, FIG. 1 shows a marketplace 102 separate from dispute resolution system 130. FIG. 2B shows an embodiment 150 of the dispute resolution system in which the dispute resolution system integrates with a business partner’s system, such as the online marketplace 102.” App. Br. 40. The Appellants go on to explain that, as shown in Fig. 2B and discussed at [0048] of the Specification, a server 160 of the dispute resolution system 150 communicates with a data manager 162 which in turn communicates

with a partner database 164. App. Br. 41. The Appellants take the view that the partner database is a part of the electronic marketplace.

The Examiner responded, disagreeing with the Appellants' view.

It appears that appellant [(sic.)] is trying to equate partner databases with the marketplace and thus infer that the marketplace has its own database. As shown in Figure 1 and identified by the applicant [(sic.)], the marketplace is separate from the seller and the dispute resolution system and the parties. Nowhere in appellant's [(sic.)]disclosure does the specification disclose the marketplace as having a separate database.

Answer 33.

In reply, the Appellants further argued that

[t]he inventors describe an online centralized trading place as a web-based community in which buyers and sellers are brought together in an auction format to interact and consummate transactions.[¶] The inventors even provided eBay.com as example of such an online trading place. [See page 11 of the Specification.] Appellant [(sic.)] submits that one of ordinary skill would easily recognize that an online trading place, such as eBay, would have a database, as recited by claims 111 and 115.

Reply Br. 9. Footnotes omitted.

We agree with the Appellants.

There is no disagreement that the Specification describes an online dispute resolution system having a database. See Fig. 2A and the corresponding discussion on p. 13 of the Specification. There is also no

disagreement that the Specification describes an electronic marketplace that is separate from the online dispute resolution system. See Fig. 1.

The only question is whether the Specification conveys to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed invention where the electronic marketplace includes a database. If the Specification discloses a system where the electronic marketplace includes a database, the Specification would necessarily convey to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed invention whereby “the online dispute resolution system and the marketplace have separate databases.”

The Appellants look to the disclosure in the Specification of partner databases and examples of electronic marketplaces, such as eBay.com, to support the view that the Specification would necessarily convey to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed invention whereby “the online dispute resolution system and the marketplace have separate databases.” We agree.

The Examiner is correct that the Specification does not explicitly state that the partner database illustrated in Fig. 1 is a part of the electronic database. It is also true that, though the Specification exemplifies various known online trading systems such as eBay.com, nowhere is there any explicit mention that these systems include a database. However, the Specification need not disclose the claimed subject matter in *haec verba*. See *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995) (“the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims . . .”) “The [written description] requirement is

rigorous, but not exhaustive: “[I]t is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention.” *LizardTech*, 424 F.3d at 1345.” *In re Alonso*, 545 F.3d 1015, 1019 n.3 (Fed. Cir. 2008). What is required is that the appellants “convey with *reasonable* clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*,” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). (Emphasis added.) In that regard, one of ordinary skill in the art would understand that electronic marketplaces, like eBay.com, necessarily include databases, without which such sites cannot operate. A database is a “collection of related information about a subject organized in a useful manner that provides a base or foundation for procedures” (*Webster’s New World Dictionary of Computer Terms*,” 142 (Eighth Edition, 2000), entry for “database.”) It is a fundamental aspect of sites like eBay.com that there be a database to collect related information about items to buy and sell and thereby provide a base for completing a transaction.

Accordingly, we find that the Specification conveys to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed invention where the electronic marketplace includes a database and thus the Specification conveys to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed invention whereby “the online dispute resolution system and the marketplace have separate databases.”

“automatically electronically communicating the transaction data between the database of the online dispute resolution system and the database of the electronic marketplace”

Fig. 1 shows the flow of transaction data between the dispute resolution system and the electronic marketplace. That the flow occurs over a network (see page 11 of the Specification) necessarily means the transaction data is automatically electronically communicated. We found that the Specification conveys to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed invention whereby “the online dispute resolution system and the marketplace have separate databases,” and given that the Specification describes automatically electronically communicating transaction data between the dispute resolution system and the electronic marketplace, we necessarily further find that the Specification conveys to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed method of resolving an electronic commerce dispute by “automatically electronically communicating the transaction data between the database of the online dispute resolution system and the database of the electronic marketplace” (claim 111).

Regarding the claimed system “wherein the online dispute resolution system comprises a data manager software application to automatically communicate data between the database of the online dispute resolution system and the database of the electronic marketplace” (Claim 115), we find that the Specification conveys to those skilled in the art that, as of the filing date sought, the Appellants were in possession of this as well. We do not construe the claim phrase “data manager software application” to mean anything more than the online dispute resolution system is required to

include a software application that manages data such that data between the database of the online dispute resolution system and the database of the electronic marketplace are automatically communicated. There is no definition in the Specification for the phrase “data manager software application” that gives the phrase a meaning different from its ordinary and customary usage. Accordingly, in order for the claim to comply with the written description requirement of the first paragraph of § 112, the Specification need only convey with reasonable clarity to those skilled in the art that, as of the filing date sought, the Appellants were in possession of a system where the online dispute resolution system includes a software application that manages data such that data are automatically communicated between the database of the online dispute resolution system and the database of the electronic marketplace. Fig. 2B shows this. As explained on page 13 of the Specification, Fig. 2B shows an implementation of the dispute resolution system. It includes a server 156 communicating with a network and with another server “which can be an e-commerce server [158].” Specification 13:20. “The server 158 is used as a Web Application Server to present HTML applications. These applications allow customers to file and manage disputes and dispute resolution specialists to manage cases over the Internet.” Specification 13:20-23. Thus this implementation of the dispute resolution system includes a software application that manages data such that data are automatically communicated between the online dispute resolution system and the electronic marketplace. Given that we have found that the Specification conveys to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed invention whereby “the online dispute resolution system and the marketplace

have separate databases,” we necessarily further find that the Specification conveys to those skilled in the art that, as of the filing date sought, the Appellants were in possession of the claimed system where the online dispute resolution system includes a software application that manages data such that data are automatically communicated between the database of the online dispute resolution system and the database of the electronic marketplace.

For the foregoing reasons, we reverse the rejection of claims 111 and 115 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement

The rejection of claims 1-17, 20-22, 25-27, 64-73, 93-100, 109-113, and 115 under § 103(a) as being unpatentable over Sloo and Collins.

The rejection of claim 108 under § 103(a) as being unpatentable over Sloo and Slaikau.

The rejection of claims 28-31, 114, 116, and 117 under § 103(a) as being unpatentable over Sloo, Collins, and TRUSTe.

We will reverse the prior art rejections for the simple reason that the cited references do not show an electronic marketplace as the claimed subject matter requires.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a). To establish a

prima facie case of obviousness, the Examiner must first (1) determine the scope and content of the prior art, (2) ascertain the differences between the prior art and the claimed subject matter, and (3) resolve the level of ordinary skill in the art. *In re Kahn*, 441 F.3d 977, 985 (Fed. Cir. 2006); *see also Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). Against that factual background, the Examiner can then determine whether the subject matter claimed would have been obvious to a person of ordinary skill in the art at the time of the invention. *Id.*

The claimed subject matter is drawn to a method of resolving an electronic commerce dispute and an online dispute resolution system. In both cases, the claimed invention involves an online dispute resolution system interacting with an electronic marketplace such that transaction data from the electronic marketplace is electronically communicated to the online dispute resolution system. Accordingly, a condition precedent to a legal conclusion of obviousness for the claimed subject matter is evidence of an electronic marketplace. In that regard, we are offered only Sloo and Collins but neither Sloo nor Collins disclose an electronic marketplace. The Appellants have correctly characterized the dispute resolution methods and systems these references disclose as involving manual entry of data and not involving an interaction with an electronic marketplace. We see no reason to address the Examiner's construction of the claims because we do not find that the broadest reasonable construction of the claims in light of the Specification as it would be interpreted by one of ordinary skill in the art would lead one to construe "electronic marketplace" to be anything other than a marketplace conducted on a network. Interpreting "electronic marketplace" to cover individuals or entities that can separately and

manually access the dispute resolution system as the Examiner has done (Answer 50) strains the reasonableness that must be applied when construing claims. Since the cited references do not show an electronic marketplace and no other evidence has been offered to show that this feature of the claimed subject matter was known to one of ordinary skill in the art, the factual basis given is insufficient to support a prima facie case of obviousness for the claimed subject matter.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 111 and 115 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; claims 1-17, 20-22, 25-27, 64-73, 93-100, 109-113, and 115 under 35 U.S.C. § 103(a) as being unpatentable over Sloo and Collins; claim 108 under 35 U.S.C. § 103(a) as being unpatentable over Sloo and Slaikeu; and, claims 28-31, 114, 116, and 117 under 35 U.S.C. § 103(a) as being unpatentable over Sloo, Collins, and TRUSTe.

DECISION

The decision of the Examiner to reject claims 1-17, 20-22, 25-31, 64-73, 93-100, and 108-117 is reversed.

REVERSED

Appeal 2008-2537
Application 09/504,159

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